

The applicant has re-lettered the paragraphs in claim 5 to be (e) and (f) to correct this informality. Claim 1 has steps (a) through (d). Claim 5 dependent from claim 1 has steps (e) and (f), and claim 34 dependent from claim 5 has steps (g) and (h).

Next the Examiner rejects claims 11, 12, 13, 35 and 36 "under 35 U. S. C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 recites the limitation 'the first document' in line 17. There is insufficient antecedent basis for this limitation in the claim. Examiner will treat the phrase as though it reads 'the object'." The applicants have amended all the claims so that "objects" are no longer referred to in the claims. Instead all the claims now refer to: "A method for automatically processing paper, plastic and electronic documents of many different classes and types" and the terms "document" or "documents" are used throughout the claims. There is no further reference to "objects" in the claims. All independent claims have been amended to read the same. No new matter has been added because in the specification at page 9, l.7&9 and page 15, l. 20, 21 it refers to RF and solid state emitters, and RF reader and smart card readers. Accordingly, claims 11, 12, 13, 35 and 36 are now believed to be allowable in this regard.

The Examiner then rejects claims 1-3, 11, 13, 33, 35 and 37 "under 35 U.S.C. 102(b) as being anticipated by US Patent 4,519,041 to Fant et al. ("Fant")." Continuing, the Examiner states that: "As to claims 1, 11 and 31, Fant discloses a method for automatically processing objects of many different classes and types that are randomly presented to first identify the class of each object, then identify the type of object within an identified class of objects, ..." (underlining emphasis added). The Examiner then equates portions of applicant's claim 1 to portions of the Fant patent. The applicants have amended all the claims to not read on "objects" that would include the steel sheet processing technology of the Fant patent. The claims now only read on "documents". The preamble of independent claim 1 now reads: "A method for automatically processing documents of many different classes and types" and the preamble of all other independent claims read similarly.

Similarly, the language in all the claims regarding “capturing a complete representation of an entire object” and other references to representations has also been amended. Amended claim 1 now reads in part: “capturing a complete image of an entire document that is presented to be identified”. The other independent claims are similarly narrowed. Accordingly, the claims are now believed to be allowable in this regard.

The Examiner then rejects claims 5, 12, 34 and 36 under 35 U.S.C. 103(a) “as being unpatentable over Fant as applied to claims 1 and 11 above, and further in view of USPN 5,933,526 to Sklarew”. The Examiner then states that “Fant and Sklarew are combinable because they are from they are both in the field of identifying objects using image processing. The lesson taught by Sklarew is completely compatible and usable with the identification method of Fant.” With the amendment made to all the claims so they now only read on capturing images of documents to identify them the applicants believe that the claims are now allowable.

A patent for identifying imperfections on hot steel sheet is entirely different than a patent for recognizing handwriting and converting it into computer text. For the applicant’s invention, as now claimed in the amended claims (identifying documents), to be obvious in view of the patent combination cited by the Examiner the need for the novel combination and operation must be at least suggested in the cited prior art or we have hindsight. The applicant respectfully contends that the invention, as now clearly claimed in the amended claims, is not suggested in any of the cited prior art.

In the key case *In re Fine*, 837 F.2d 1074, 5 USPQ2d 1596, (Fed. Cir. 1988), the court stated:

“But whether a particular combination might be ‘obvious to try’ is not a legitimate test of patentability. Obviousness is tested by ‘what the combined teachings of the references would have suggested to those of ordinary skill in the art’, but it ‘cannot be established by combining the teaching of the prior art to solve the problem of the claimed invention, absent some teaching or suggestion supporting the combination.’ Here the prior art contains none. And ‘*teaching of*

*references can be combined only if there is some suggestion or incentive to do so.*’ Here the prior art contains none.”

“Instead, the Examiner relies on hind sight in teaching his obviousness rejection. “But, this court has said, to ‘imbue one of ordinary skill in the art with the knowledge of the individual, in suite, when no prior art reference or references as of record convey or suggest that knowledge is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teaching’. It is essential that ‘the decision maker forget what he or she has been taught about the claimed invention and casts the mind back to the time the invention was made ... to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then accepted wisdom in the art.’”

“id. One cannot use hindsight reconstruction to pick and choose among isolated disclosures of the prior art to deprecate the claimed invention.”

Again in *Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc.*, 37 USPQ2d 1237 (Fed.Cir. 1995) the court stated:

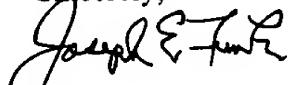
“For a combination of prior art references to render an invention obvious, “there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.” *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). That one must point to some reason, suggestion, or motivation to make a combination is not to say that the teaching must be explicit, but in order to render an invention obvious by the combination of prior art references, the record must contain some basis to rebut the presumption of validity. See, e.g., *Vandenberg v. Dairy Equip. Co.*, 740 F.2d 1560, 1568, 224 USPQ 195, 198 (Fed. Cir. 1984). A finding of obviousness on any other basis would constitute hindsight. See *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227

USPQ 543, 551 (Fed. Cir. 1985) ("When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.")."

"A simple invention may be patentable, even if the invention comprises the combination of features known in the art, provided the combination itself is not obvious. See *In re Sponnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969) ("A patentable invention, within the ambit of 35 U.S.C. § 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use.")

Thus, the applicants respectfully believe that the amended claims are now allowable.

In view of the above arguments, cancellation of claims, new claims and the amendments to the remaining claims, this patent application is now believed to be in condition for allowance and passage to issuance is respectfully requested. If there remain any matters that may be resolved by telephone the Examiner is invited and authorized to contact the undersigned attorney via telephone at (603) 432-8788, via fax at (603) 421-2779, or via e-mail at [jfunk777@adelphia.net](mailto:jfunk777@adelphia.net).

Sincerely,  
  
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